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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,544	04/20/2001	Paul Gilson	08157.0011	9269

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EXAMINER

NERBUN, PETER P

ART UNIT

PAPER NUMBER

3765

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

Office Action Summary

Application No.

09/838,544

Applicant(s)

GILSON ET AL.

Examiner

Peter P Nerbun

Art Unit

3765

-- **Th MAILING DATE of this communication app ars on th cover she t with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,26-43 and 45-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,11,26,27,31 and 45-55 is/are rejected.
- 7) ☒ Claim(s) 7-10,12-24,28-30 and 32-43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 28 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

The disclosure is objected to because of the following informalities: the specification contains numerous errors in grammar and syntax. For example, note page 30, line 16 ("stain" should be changed to --strain--); page 30, line 23 ("or" should be changed to --of--); page 31, line 1, "2" should be changed to --21--; page 35, line 25 ("visualisation" should be changed to --visualization--); page 36, line 3 ("made" should be changed to --with--); page 43, line 2 ("minimizes" should be changed to --minimizes--); page 48, line 7 ("centering" (both occurrences) should be changed to --centering--).

Claims 26 and 36-43 are objected to for containing a grammatical error. In claim 26, line 5, and in claim 36, line 1, "a" should be changed to --an--.

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 11, 26, 27, 31, 45-48, 51, 52, and 55/45 - 55/48 are rejected under 35 U.S.C. 102(e) as being anticipated by Forber et al. The patent to Forber et al discloses an assembly for loading a collapsible protection device 100, Figs. 1, 18 into a catheter, the assembly comprising a catheter 120, Fig. 18 defining a reception space at a distal end 47 of the catheter for receiving a collapsed protection device, and a separate removable pushing device 95, 96, Figs. 16-18 for delivering the medical device (i.e. the protection device) into the reception space. The recitation that the device to be loaded is "an embolic protection filter" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is

drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). With regard to the recitation that the catheter defines a space "for receiving a collapsed embolic protection filter" note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (viz. receiving a filter instead of an occlusive device) does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 49, 50, and 55/49 - 55/52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forber et al. With regard to the specific dimension of the small diameter portion it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claims 53, 54, 55/53, and 55/54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forber et al in view of Walker et al. To construct the Forbes et al medical device with a polytetrafluoroethylene coating on the stem as suggested by Walker et al (see col. 9, lines 2-8) would have been obvious since such a coating would enhance the low friction relative movement between the various components.

Claims 7-10, 12-24, 28-30, and 32-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Claims 36-43 will be deemed allowable upon correcting the grammatical error noted above in the objection to claim 36.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter P Nerbun whose telephone number is 703-308-0955. The examiner can normally be reached on M-F (1st Week) M-Th (2d Week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John J Calvert can be reached on 703-305-1025. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

Peter Nerbun
January 22, 2003


Peter Nerbun
Primary Examiner